

Applicant: Aghamehdi, et al.
Serial No.: 10/796,393:
Filed: 03/09/2004
For: FUEL MEASURING CELL

Art Unit: 2858:
Examiner: Dole, Timothy J

Page 3 of 5

REMARKS/ARGUMENTS

The objection to Claim 3 is noted and the claim has been amended to obviate the objection.

Claim 1, and thus, all of the remaining claims, which depend therefrom, has been amended to expedite prosecution and too more clearly point out the differences between the instant invention and the cited art.

The rejection of Claims 1 and 4 under 35 U.S.C. §102(b) as being anticipated by Desmier et al. (US 2003/0020494, hereinafter, Desmier) is respectfully traversed and reconsideration is requested.

As noted Claim 1 has been amended by including the limitation of Claim 4 (which has been cancelled) to more particularly point out the shape of the electrode. Additionally, the claim has been amended to point out that the electrode has a solid wall. It is believed that fact should have been apparent from the description of the electrode as "cup-shaped"; however, evidently that was not the case.

"Factual determination of anticipation requires disclosure in single reference of every element of claimed invention, and examiner must identify wherein each and every facet of claimed invention is disclosed in applied reference." **Ex parte Levy**; 17 USPQ2d; PTO Bd of Pat. App. and Int.; October 16, 1990

In the instant claims, as noted above, there are two requirements; namely, that the inlet and outlet orifices be at different levels and that the electrode be cup-shaped with a solid wall. The electrode of Desmier clearly does not have a solid wall, it is provided with a plurality of openings 28. (See Desmier, paragraph [0033], lines 1 and 2). The openings are a necessary feature of Desmier because a second electrode is included within the first and the fuel must flow therebetween.

Accordingly, the reference must fail as an anticipation and withdrawal of the rejection is requested.

code

Applicant: Aghamehdi, et al.
Serial No.: 10/796,393:
Filed: 03/09/2004
For: FUEL MEASURING CELL

Art Unit: 2858:
Examiner: Dole, Timothy J

Page 4 of 5

The rejection of Claim 2 under 35 U.S.C. §103(a) as being unpatentable over Desmier in view of Gilmour U.S. 6,555,754 (hereinafter, '754) is respectfully traversed and reconsideration is requested. Gilmour '754 is cited for the showing of a glass seal between the housing and the electrode; however, since the basic reference to Desmier has two electrodes, one within the other, to which electrode is the glass seal applied and how would that effect the operation of Desmier's cell?

"In determining obviousness of claimed apparatus under 35 U.S.C. 103, it is improper to modify reference in light of applicant's own disclosure." Ex parte Camarata; 151 USPQ 739; PO Bd of App; Mar. 1 and May 17, 1966

"Fact that disclosures of references can be combined does not make combination obvious unless the art also contains something to suggest desirability of combination." In re Imperato; 179 USPQ 730; CCPA; Nov. 15, 1973.

It is respectfully submitted that there is no suggestion in the combination of references proposed by the examiner and it respectfully requested that the rejection be withdrawn.

The rejection of Claim 3 under 35 U.S.C. §103(a) as being unpatentable over Desmier in view of McKenzie et al. (U.S. 6,842,017, hereinafter, '017) is respectfully traversed and reconsideration is requested.

McKenzie is cited for a showing of mounting ears; however, this combination with Desmier would provide an unworkable Desmier cell.

"Examiner's combination of primary and secondary references is improper in case in which there is no basis in record from which it can be reasonably inferred that one skilled in art would have been led or motivated to modify primary reference in manner proposed by examiner and modification of primary reference's structure in proposed manner would lead to inoperative construction." Ex parte Acosta; 211 USPQ 636; PTO Bd. of App.; 12/27/79

The cell of Desmier is designed for insertion into a fuel line as a plug-in unit or a screwed-in unit (Desmier paragraph [0036]). Alternatively, Desmier's embodiment in Figs. 12 and 13 (see paragraphs [0060] and [0061]) requires a direct connection of the

code

Applicant: Aghamehdi, et al.
Serial No.: 10/796,393:
Filed: 03/09/2004
For: FUEL MEASURING CELL

Art Unit: 2858:
Examiner: Dole, Timothy J

Page 5 of 5

fuel lines through connectors 156 and 160. Where are the mounting lugs supposed to be located?

Accordingly, this rejection is in error and its withdrawal is respectfully requested.

The rejection of Claim 5 under 35 U.S.C. §103(a) as being unpatentable over Desmier in view of Kopera (US 5,550,478, hereinafter, '478) is respectfully traversed and reconsideration is requested.

The inappropriateness of the primary reference, Desmier, has been discussed above. The addition of '748 does little to add to the teachings of Desmier. Further, the device of '748 is an inline device. It does not have inlet and outlet orifices at different levels and the only suggestion that the latter type of inlet and outlet orifices have rounded corners comes from the instant specification and, as noted by the cases cited above, that teaching is not available to the Examiner.

Accordingly, in view of this amendment and these remarks it is believed that this application is in condition for immediate allowance and such action is earnestly solicited.

Respectfully submitted,



William H. McNeill

Reg. No. 24,426

For:
OSRAM SYLVANIA Inc.
100 Endicott Street
Danvers, MA 01923

Tel.: (321) 544-5292
Fax: (321) 452-6515

03-2-309 amendment/md/appin

code